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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,897	12/26/2001	Peter J. Kight	23952-0039	9205

29052 7590 03/09/2007
SUTHERLAND ASBILL & BRENNAN LLP
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EXAMINER

RIoux, JAMES A

ART UNIT	PAPER NUMBER
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3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/025,897

Applicant(s)

KIGHT ET AL.

Examiner

James Rioux

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-75 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 2-75 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 2/26/2007.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

1. Claims 2 through 75 have been reviewed in the patent application numbered 10/025897 by Kight et al (hereinafter referred to as the Application).

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - A. Claims 2 – 13, drawn to a bill payment method via computer with two payment options, tentatively classified in class 705, subclass 40.
 - B. Claims 14 – 19, drawn to a bill payment method via computer with a search of account numbers for payment, tentatively classified in class 705, subclass 40.
 - C. Claims 20 – 28, 30, drawn to a bill payment method via computer with negotiable instruments through Electronic Funds Transfer, tentatively classified in class 705, subclass 39.
 - D. Claims 29, drawn to an article of manufacture for a bill payment method via computer with two payment options, tentatively classified in class 705, subclass 40.
 - E. Claims 31 - 32, drawn to a system for a bill payment method via computer with two payment options, tentatively classified in class 705, subclass 40.
 - F. Claims 33 - 35, drawn to a system for a bill payment method via the Internet, tentatively classified in class 705, subclass 40.

G. Claims 36 - 55, drawn to a method of processing payments with a risk score, tentatively classified in class 705, subclass 38.

H. Claims 56 - 75, drawn to a system of processing payments with a risk score, tentatively classified in class 705, subclass 38.

2. The inventions are **distinct** if it can be shown that either: (1) the process as claimed can be practiced by another and materially ***different apparatus*** or by hand, or (2) the ***apparatus*** as claimed can be used to practice another and materially ***different process***. (MPEP § 806.05(e)).
3. Here, the (1) ***different apparatus*** element is satisfied because the application is capable of obtaining eight distinct patents. Invention A can be patented as a bill payment system with two payment options. Invention B can receive it's own patent as a bill payment system that searches for and bills the appropriate bank account. Invention C can be patented as a bill payment method that utilizes Electronic Funds Transfer. Invention D can receive it's own patent as an article of manufacture for a bill payment system via computer with two payment options. Invention E can receive it's own patent as a system for a bill payment system with two payment options. Invention F can receive it's own patent as a system for a bill payment system operating via the Internet. Invention G can receive it's own patent as a method for bill payment system with a risk score. Invention H can receive it's own patent as a system for bill payment system with a risk score. Here, the ***apparatus different process*** element is satisfied because the bill payment systems are each a unique patentably distinct business method.

Art Unit: 3694

4. In addition, Inventions A,B,C,D,E,F, G and H are independent because there is no disclosed relationship between the eight sets of claims. Invention A is not connected to Invention B,C,D,E,F, G or H in design, operation, or effect because Invention A primarily allows a consumer to make bill payments through two options. The same is true for all of the various bill payment methods because each has their own distinct method resulting in a payment.
5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
6. Furthermore, the Inventions are a serious burden on the examiner because each analysis method will require a completely separate field of search namely: Inventions G and H will require a search in class 705, subclass 38. Invention C will require a search in class 705, subclass 39. Inventions A, B, D, E, and F will require a search in class 705, subclass 40.
7. During a telephone conversation on 2/26/2007, Christopher Chan and Rhett White, the representatives for the inventor, made no election and indicated that amendments maybe made once the representatives become familiar with the file. The representatives also requested a telephone interview on 2/28/2007 with the examiner at 2:00 PM. Affirmation of this election must be made by applicant in replying to this Office action.

Art Unit: 3694

8. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.
9. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.
10. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Rioux whose telephone number is (571) 272-7326. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone

Art Unit: 3694

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Rioux
Patent Examiner
Art Unit 36-94

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JR
2/26/2007


ELLA COLBERT
PRIMARY EXAMINER